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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,617	10/17/2003	Sumio Kamo	244146US0	8956

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EXAMINER

KOSLOW, CAROL M

ART UNIT PAPER NUMBER

1755

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,617

Applicant(s)

KAMOI ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 27-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Applicant's election with traverse of Group I, claims 1-26 in the paper dated 19 December 2005 is acknowledged. The traversal is on the grounds that there is no serious burden to search both invention, that the Examiner has not shown the process can be used to make another and materially different product and that the Examiner has stated an opinion. This is not found persuasive because separate classification is a *prima facie* showing of a serious burden and that has been no showing by applicants rebutting this showing, the Examiner does not have to present evidence showing the process can be used to make another and materially different product and applicants have not presented any evidence showing the process cannot be used to make another and materially different product (see MPEP 806.05(f)) and the fact that reasons for restriction are not opinions, but based on the fact that it would be a serious burden to examine the separate and distinct inventions.

The requirement is still deemed proper and is therefore made FINAL.

Claims 27-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

The information disclosure statement filed 11 November 2004, 14 December 2004, 15 February 2005 and 20 October 2005 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

The supplied list does not meet the requirements of 37 CFR 1.98 as revised 21 October 2004. See MPEP 609.04 (a).

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The list of related cases filed with the information disclosure statement of 13 January 2004 meet the requirement of 37 CFR 1.98 since it was filed before the revision of 21 October 2004.

Copending applications 08/644,026 and 09/594,482, cited in the list of related cases filed with the information disclosure statement of 13 January 2004, have lines drawn through them since they are abandoned.

The patents, cited on the list of related cases filed with the information disclosure statement of 13 January 2004, also appear on form PTO-1449. Thus, the citations of these patents on the list of related cases have lines drawn through them.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The disclosure is objected to because of the following informalities: On page 15, line 16, the phrase "rare earth resin" is unclear as to its meaning. On page 17, line 14, "0.3 wt.% and 8 wt.%" should be "0.3 wt.% and 0.8 wt.%" to correspond with the teachings in the claims and to fall within the broad range given in this line. Appropriate correction is required.

Claims 8, 13, 18 and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 8, 13, 18 and 23 teach the mean grain size of the resin is one-length of a mean grain size of the magnetic powder. This is not found in the specification. Page 20 of the specification teaches the mean grain size of the resin is one-tenth of a mean grain size of the magnetic powder. This discrepancy needs to be corrected.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 13, 18 and 23 teach the mean grain size of the resin is one-length of a mean grain size of the magnetic powder. It is unclear what size corresponds to "one-length of the mean grain size of the magnetic powder". Claims 1-26 are improper Jepson claims. It is unclear what aspects of the claims applicants' consider the improvement and what aspects of the claims are known in the art. Claim 1 is indefinite since the particle sizes applicants' consider as "fine" are not defined.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 34 of copending Application No. 10/820,052. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of claim 34 in the copending application teaches the claimed magnet compound material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. patent 4,137,188.

This patent teaches a mixture of magnetic powder, thermoplastic resin particles, a pigment and a charge control agent. While the resin particle size is not taught, it is clear the resin particles are of such a size so as to allow the mixture to be thoroughly mixed and thus they are fine. The compositional mixture clearly teaches the claimed mixture.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,137,188.

As stated above, this reference teaches the claimed mixture. The reference teaches the thermoplastic resin has a softening temperature in the range of 60-120°C (col. 5, lines 67-68), which overlaps the claimed range. The reference suggests the claimed mixture.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,342,557 or 6,338,900.

Both of these references suggest a magnetic composition comprising a mixtures of magnetic particles, fine thermoplastic particles and a pigment.

Claims 1 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,626,371.

This reference suggests a magnetic molding formed by compression molding, in a magnetic field, a mixture of magnetic particles, fine thermoplastic particles and a pigment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
January 30, 2006


C. Melissa Koslow
Primary Examiner
Tech. Center 1700